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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,604	03/31/2004	Thomas Palmieri	2006P26237 US	4357

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SIEMENS CORPORATION  
INTELLECTUAL PROPERTY DEPARTMENT  
170 WOOD AVENUE SOUTH  
ISELIN, NJ 08830

EXAMINER
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WRIGHT, PATRICIA KATHRYN

ART UNIT	PAPER NUMBER
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1743

MAIL DATE	DELIVERY MODE
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10/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/813,604	PALMIERI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	P. Kathryn Wright	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "plurality of vessel holding members" and "controller" in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

3. The disclosure is objected to because of the following informalities: the reference to co-pending US patent application at page 14, lines 22 should include the patent application no.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said plurality of vessels" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites wherein 6 wherein each holding member of the plurality of vessel holding members are locatable at a plurality of spaces equal in number to the plurality of vessel holding members, and wherein the transport device moves a preset number of spaces that is greater than one with every move. This is confusing and definite since it is not clear what distance constitutes a "space". Similar deficiency was found in claims 7-8. Furthermore, the process limitations describing the movement of the transport device in an apparatus claim is merely an intended use which the prior art would

inherently be capable of doing. A recitation of function may not distinguish over the prior art reference since an apparatus claim covers what a device is, not what it does.

Similarly, claim 12 recites "a transfer device which moves a vessel from the transport device to at least one position spaced away from vessel holding members of the transport device." It is not clear what Applicant means by "one position spaced away". What does one position correspond to? Same deficiency was noted in claims 13-15, and 19-21. Again, the process limitations describing the movement of the transport device is merely an intended use which the prior art would inherently be capable of doing. A recitation of function may not distinguish over the prior art reference since an apparatus claim covers what a device is, not what it does.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4, 6-22, 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Babson et al. (US Patent no. 5,885,529), hereinafter "Babson".

Babson teaches a multipath access system for use in an automated immunoassay analyzer and method for using the same. Babson system comprises a transport device (e.g., loop 202) having a plurality of vessel holding members (e.g., 202a). The transport device moves a plurality of vessels 840 along one or more

continuous loops (e.g., 202, 213b, 213). The multipath system of Babson also includes at least one delivery station 201 for adding a vessel to the transport device at a specified vessel holding member of the plurality of vessel holding members, two transfer stations (204; col. 5, lines 43-46 and 2<sup>nd</sup> transfer station, see col. 17, lines 31-50; claim 16) for removing a vessel from and replacing a vessel onto the transport device, and a controller 12 for controlling the transport of a vessel by the transport device from the delivery station to the transfer stations based on information (i) identifying a test or operation being performed in said vessel, and (ii) identifying a location of a vessel holder which holds said vessel within said transport device; see for example col. 10, lines 17-54).

Moreover, the Babson system also further comprising pipetting stations (207 and bead dispenser and carousel 203) for adding one or more reagents to a vessel positioned in a vessel holding member of the transport device (claim 2). Babson also teaches wash station 214 and 810 (fig. 8A) for washing test vessels positioned therein (claim 3). Note that the Examiner considers the wash station combined with the transfer station (e.g., 213b) which transfers the tube from the wash station to either the side chain transport device 213' or luminometer chain 215a to a luminometer 216 (claim 14). The transfer station in the wash station is shown in detail in Figs. 8A-E. The reaction tube 840 in transfer/wash station is lifted (and retracted) vertically along the z-z axis direction via a slide member (tube elevating means 850), such as shown in FIG. 8A. Tube elevating means 850 includes a tube holder 851 and projections 852, 853

which hold and retains tube 840 during lift of tube 840 in direction perpendicular to the path traveled by the transport device (see col. 27, line 64- col. 30, line 55).

With respect to claims 9 and 26, Babson teaches a stationary agitating means (reaction tube shaker bars; not shown; see col. 7, lines 57+) positioned adjacent the transport device at a location where the vessels in the holding members contact the agitating member when the transport device 213 is moved.

Claims 6-8, 12-15, and 19-21 include process limitations describing the movement of the transport device in an apparatus claim. These limitations are considered merely an intended use which the prior art would inherently be capable of doing. A recitation of function may not distinguish over Babson since an apparatus claim covers what a device is, not what it does. Furthermore, claim 12 recites that the slide member can move at least two vessels simultaneously. The recitation that an element "can" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

8. Claims 1-3, 5-8, 11-12, 14-16, 22-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Babson et al. (US Patent no. 5,316,726), hereinafter "Babson".

Babson teaches a multipath access system for use in an automated immunoassay analyzer and method for using the same (see Figs 2-3). Babson system comprises a transport device (e.g., loop 52, 58, 80, 92) having a plurality of vessel holding members (e.g., chain loop). The transport device moves a plurality of vessels 27, 28 along one or more continuous loops of the transport device. The multipath

system of Babson also includes at least one delivery station 50 for adding a vessel to the transport device at a specified vessel holding member of the plurality of vessel holding members, transfer station (80) for removing a vessel from and replacing a vessel onto the transport device, and a controller 12 for controlling the transport of a vessel by the transport device from the delivery station to the transfer stations based on information (i) identifying a test or operation being performed in said vessel, and (ii) identifying a location of a vessel holder which holds said vessel within said transport device; see for example col. 4 lines 44-65).

Moreover, the Babson system also further comprising pipetting station (42) for adding one or more reagents to a vessel positioned in a vessel holding member of the transport device (claim 2). Babson also teaches wash station 82 for washing test vessels positioned therein (claim 3). The transfer device 80 reversibly transfers (see arrows in Fig. 2) the tube to the incubation chain 52 or the luminometer chain 92 and to a luminometer 96 (claim 14).

Claims 6-8, 12-15, and 19-21 include process limitations describing the movement of the transport device in an apparatus claim. These limitations are considered merely an intended use which the prior art would inherently be capable of doing. A recitation of function may not distinguish over Babson since an apparatus claim covers what a device is, not what it does. Furthermore, claim 12 recites that the slide member can move at least two vessels simultaneously. The recitation that an element "can" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.



With respect to claim 26, Babson teaches agitating the plurality of vessel during the transporting in the loop 54 (see for example col. 7, lines 10-29).

### ***Conclusion***


9. No claims are allowed.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is 571-272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 27, 2007

pkw

  
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